

## REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner continues to reject claims 13, 14 and 16-18 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,843,789 to Goble (hereinafter “Goble”).

Firstly, independent claims 13 and 16 and dependent claim 14 have been canceled, thereby rendering the rejection thereof moot.

Secondly, independent claims 17 and 18 have been amended to clarify their distinguishing features. Specifically, with regard to claim 17, the same has been amended to recite:

“identifying subject tissue by categorizing the subject tissue by detecting the maximal current value flowing to the subject tissue and comparing the maximum current value regarding the categorized subject tissue with a second threshold value”

Independent claim 18 has been similarly amended.

The amendments to claims 17 and 18 are fully supported in the original disclosure. Thus, no new matter has been introduced into the disclosure by way of the present amendments to independent claims 17 and 18.

Applicants respectfully submit that Goble at least does not disclose or suggest detecting a living body tissue by the combination of the time up to the maximum value and the maximum value. That is, Goble does not expressly or inherently describe how to perform control using the time up to a maximum value. In contrast, Goble merely detects the time in place of detecting a parameter, such as volume. Goble merely detects a living body tissue based on the result of detecting time or volume.

The electric surgery methods of claims 17 and 18 identify the subject tissue by first detecting the time up to the maximum current value thereby narrowing down the categorized results, and further using the maximum current value detected of the categorized subjects. Independent claims 17 and 18 have been amended as described above to clarify such distinguish features.

Thus, Applicants respectfully submit that Goble at least does not disclose or suggest the features now clarified in claims 17 and 18.

With regard to the rejection of claims 13, 14 and 16-18 under 35 U.S.C. § 102(b), an electric surgery method having the features discussed above and as recited in independent claims 17 and 18, is nowhere disclosed in Goble. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”<sup>1</sup> independent claims 17 and 18 are not anticipated by Goble. Accordingly, independent claims 17 and 18 patentably distinguish over Goble and are allowable (claims 13, 14 and 16 being canceled). Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 13, 14 and 16-18 under 35 U.S.C. § 102(b).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone

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<sup>1</sup> Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

conference with Applicant's attorneys would be advantageous to the disposition of this case,  
the Examiner is requested to telephone the undersigned.

Respectfully submitted,

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